PATENT

Attorney Docket No. SIC-00-001-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: KENJI OSE Application No.: 09/992,597 Filed: November 14, 2001 For: SWITCH STYLE BICYCLE SHIFT CONTROL DEVICE	Examiner: Chong Hwa Kim Art Unit: 3682 REBUTTAL BRIEF

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Commissioner for Patents
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Commissioner:

This is a rebuttal brief for the above-captioned matter.

The rejection of claims 34-37, 43-47, 49-52, 73 and 74 as being anticipated by Higuchi.

Claim 34 requires the finger contact projection to protrude radially inwardly from a radially innermost outer peripheral surface of the dial so that the shift control device is operated by grasping the finger contact projection with the two fingers or the finger and the thumb radially inwardly from the radially innermost outer peripheral surface such that the rotational axis is sandwiched between the two fingers or the finger and the thumb. The Examiner's Answer at page 11, middle paragraph, states that Higuchi shows, in Fig. 2, a slanted/sloped portion of the projection (8) that is overextended onto the bottom surface of dial (9). However, Higuchi does not say that the slanted/sloped line illustrating the portion of lever (8) near the bottom portion of wire winding element (9) extends radially inwardly from the outer peripheral surface of wire winding element (9), so the Examiner's Answer must be alleging that the slanted/sloped line in Fig. 2 inherently depicts lever (8) extending radially inwardly of the outer peripheral surface of wire winding element (9). It

is well settled that inherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art. *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 64 USPQ.2d 1676 (Fed.Cir. 2002). It is more likely that the horizontal line projecting to the left into the lever portion (10a) merely represents a crease where the lever portion (10a) makes the transition from the vertical side surface of wire winding element (9) to the horizontally extending outer peripheral surface of lever portion (10a). It certainly does not necessarily mean that lever (8) extends radially inwardly of the outer peripheral surface of wire winding element (9).

Even if the slanted/sloped line did represent level (8) extending radially inwardly from the outer peripheral surface of wire winding element (9), there is no information about the shape of such a projection. It could be mildly sloped in the circumferential direction of wire winding element (9) such that it is impossible to grasp, and/or there may be an insufficient amount of any radially inwardly extending portion to grasp, given the fact that the alleged radially inwardly extending portion inclines upwardly toward the bottom surface of wire winding element (9). There simply is no basis to conclude that one of ordinary skill in the art would read Higuchi as disclosing a radially inwardly extending portion that could be grasped in the manner recited in claim 34 in order to operate the device.

Similarly, as for claim 73, there is no basis to conclude that the device could be operated by placing two fingers or a finger and a thumb on either the alleged radially inwardly extending portion or any other portion of lever (8) such that the rotational axis is *sandwiched between and adjacent to* the two fingers or the finger and the thumb, especially when it is necessary to wrap the two fingers or the finger and the thumb *around* wire winding element (9) as stated in the Examiner's Answer. Furthermore, when the two fingers or the finger and the thumb are wrapped *around* the wire takeup element (9) (i.e., around the sides of wire takeup element (9)) as stated in the Examiner's Answer, it precludes the possibility that the fingers *abut against the dial in the direction of the rotational axis* as recited in claim 74. At most, the two fingers or the fingers and the thumb would abut against the dial in a direction *perpendicular* to the rotational axis. Thus, the functional limitations of claim 73 do provide a *structural* difference over Higuchi.

Finally, the Appellant is not trying to patent a new use of a prior art device. When it is argued that a prior art device is *incapable* of being used in a manner alleged, it is because the *structure* of the prior art device fails to allow such use, and therefore the claims *structurally* distinguish over that prior art device.

The rejection of claims 34-37, 40, 41, 44, 49-51, 53, 61-65, 73 and 74 as being obvious over Wechsler in view of Higuchi and Knop.

The comments bridging pages 12-13 of the Examiner's Answer reduce to the assertion that there are many different dials in existence, so it would be obvious to use any one of them in any situation. That simply is not the law. There must be a suggestion somewhere other than the Appellant's disclosure why one would want to use the particular projection disclosed in Knop in the Wechsler device. The Examiner's Answer explains that Wechsler's circular grip "could" be too cumbersome to rotate, or that "perhaps" the operator has physical limitations that would make such a configuration desirable. That is improper speculation and , in fact, underscores the simple but great advance of the Appellant's claimed invention over the Wechsler device. Such admirable advantages occur in the claimed invention, but not in the prior art. *Nowhere* is it recognized that a bicycle shift control device could have such advantages using the claimed structure. The Appellant's teachings are being used against him to deny him protection for a flash of genius.

Regarding the comments bridging pages 13 and 14 of the Examiner's Answer, the Appellant is not arguing that a prior art device must be capable of direct physical incorporation into another prior art device or that the prior art must expressly suggest the combination. The point is that the claimed invention provides a completely different user interface from the Wechsler device, and there is no suggestion in the prior art to completely destroy the theory of operation of Wechsler's user interface in order to make it operate in the manner provided by the structure recited in the Appellant's claims. The only suggestion to do so comes from the Appellant's disclosure.

The rejection of claims 54 and 55 as being obvious over Wechsler in view of Higuchi and White.

The Examiner's Answer finds motivation to use White's snap-in attachment between a male terminal of a cable and a control element in order to eliminate the need for strict control of tolerances between the two components. It is not proper to use such a generic statement separated from its context. The White patent is directed to devices for communicating movement from a cable to a control device. As stated in column 1, lines 33-60 of White, prior art devices have looseness where the cable connected to the control device, thus creating the risk that the control device will not be placed in the proper position by the cable movement. In the Wechsler device, the drum (22) is journaled on a bolt (34), the bolt (34) being securely fastened using one or more unnumbered nuts. The bolt (34) is not used to pull or push drum (34) to control the position of endless cable (20). The position of cable (20) is controlled by the rotational position of drum (22), not by any position of drum (20) perpendicular to the axis of bolt (34) as would occur in the White device. There is no evidence of any problem of tolerances in the Wechsler device that could be solved by the teachings of White. The reference to conclusory and speculative increases in productivity also is improper.

Respectfully submitted,

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